

REMARKS

Applicant earnestly but respectfully requests entry of the Amendment and the following remarks. Applicant further respectfully but earnestly requests the Examiner to reconsider all objections and rejections and pass this case to allowance.

Amended claims 1 and 8 include language relating to "R" and "L" based on the specification at pages 9-10. The claims are therefore definite and Applicant respectfully requests the Examiner to reconsider and withdraw the objection under 35 U.S.C. §112(¶2).

As Applicant respectfully submits claims 3 and 4 define unobvious inventions over the Masubuchi et al. reference. This reference neither discloses nor would it have taught a thermoplastic foam molding in which a projection is formed on a substrate made up of a foam layer and a skin layer, both layers being of the same material, so that the R/L ratio may fall within a range of 3 to 50.

The Masubuchi et al. reference fails to teach the specific claimed foamed ratio for the joint between the substrate and the projection of the specific claimed foamed ratio for the projection. Office Action, page 4. This reference does not disclose the joint between the substrate and projection having a foamed ratio of from 1 to 3. This reference does not disclose the projections having an average foamed ratio of from 1 to 1.3 times.

Contrary to the Office Action, Masubuchi's Fig. 1 would not have suggested Applicant's foamed ratio. The description of Fig. 1 at page 2, lines 40-45 nowhere discloses the foamed ratio for the joint between the substrate and the projection of 1 to 1.3 times, nor does it disclose an average foamed ratio for the projection of 1 to 1.3 times. The mold described with reference to Fig. 1 similarly lacks disclosure or suggestion of the ratios. See Masubuchi et al. at page 4, lines 30-46. The description of expansion coefficients at page 5 also appears lacking.

These deficiencies in the applied reference are not overcome by reliance on an alleged rule of "routine experimentation" that is statutorily proscribed by 35 U.S.C. §103(a),

even if the rejection cites a provision the MPEP. *See, e.g., In re Fay*, 347 F.2d 597, 146 U.S.P.Q. (BNA) 47 (CCPA 1965) ("Of repeated rules, like oft repeated myths, seem to die hard."). The court in the *Fay* case specifically reversed and stated "we do not agree that "routine experimentation" negatives patentability. The last sentence of section 103 states that "patentability shall not be negated by the manner in which the invention was made.""¹ Even if, *arguendo*, there were such a prophylactic rule, which there is not, it would be inapposite because there is no factual predicate - no evidence - for invoking it. *See, e.g., In re Lee*, Appeal No. 00-1158 (Fed. Cir. Jan. 2002) (reversing rejection because there was no evidence adduced to support the conclusions of the Examiner and the Board).

It is respectfully, but earnestly, submitted that a rejection bottomed on 'routine experimentation' being guided by the desired end results is misplaced. The end results (ratios) were not in the cited reference (Office Action, page 4), nor is there evidence from the applied reference that the ratio(s) would have been suggested. Accordingly, the rejection founders because it requires impermissible hindsight (Applicant's results) to guide the alleged 'routine experimentation.'

Furthermore, the Office Action candidly recognizes the Masubuchi et al. reference fails to teach the specific claimed foamed ratio for the joint between the substrate and the projection of the specific claimed foamed ratio for the projection. Office Action, page 4. Therefore, resurrecting the almost 50-year old optimization argument from *in re Aller* (see the MPEP citation relied on the Office Action) misses the point. Even if, *arguendo* optimization were a factor at all, the reference does not appear to disclose a foamed ratio - as

¹ 35 U.S.C. § 103 Revision Notes and Legislative Reports, 1952 Notes ("[I]t is immaterial whether [the invention] resulted from long toil and experimentation or from a flash of genius."); *Life Techs., Inc. v. Clontech Labs., Inc.*, 224 F.3d 1320, 1325 (Fed. Cir. 2000) (stating that "the path that leads an inventor to the invention is expressly made irrelevant to patentability by statute"). *See, also, In re Cormany*, 407 F.2d 900 (CCPA 1969) (acknowledging allegations of routine experimentation are not adequate for an obviousness rejection); *In re Tomlinson*, 363 F.2d 328 (CCPA 1966) (arguments by Examiner and Board that it would be routine experimentation "simply...begs the question").

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is apparently admitted in the Office Action, whereby it follows that the reference would not have suggested a variable to optimize. An Aller-type rejection is simply inapposite.

The rejection at best may be said to rest on an obvious to try argument. Section 103 is not satisfied by an obvious to try argument. In re Tomlinson, 363 F.2d 928, 150 U.S.P.Q. (BNA) 623 (CCPA 1966). The Tomlinson court observed "there is usually an element of 'obvious to try' in any research endeavor, that is not undertaken with complete blindness but rather with some semblance of a chance of success." Tomlinson, 363 F.2d at 931, 150 U.S.P.Q. (BNA) at 626. However, the Tomlinson court specifically held that permitting patentability determinations based on an "obvious to try" standard "would not only be contrary to the statute but result in a marked deterioration of the entire patent system as an incentive to invest in those efforts and attempts which go by the name of 'research'" *Id.*

Applicant has endeavored to respond fully to all matters raised in the Office Action, but if the Examiner considers an aspect wanting in any respect, please telephone Applicant's representative to arrange for an interview before issuing any further action.

Applicant earnestly but respectfully requests that the application receive a Notice of Allowance.

Respectfully submitted,
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